

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB      AUG. 26, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Dorn Technology Group, Inc.

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Serial No. 75/212,508

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Thomas E. Anderson of Gifford, Krass, Groh, Sprinkle,  
Patmore, Anderson & Citkowski, P.C. for Dorn Technology  
Group, Inc.

Laverne Thompson, Trademark Examining Attorney, Law Office  
113 (Meryl Hershkowitz, Managing Attorney)

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Before Hanak, Hairston and Bottorff, Administrative  
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Dorn Technology Group, Inc. (applicant) seeks  
registration of UNIVERSAL RISK SYSTEMS in typed drawing  
form for "insurance risk management services." The intent-  
to-use application was filed on December 13, 1996.

The Examining Attorney has refused registration  
pursuant to Section 2(e)(1) of the Lanham Trademark Act on

the basis that applicant's proposed mark is merely descriptive of applicant's services.

When the refusal was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

As has been stated repeatedly, "a term is merely descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]." In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 189 USPQ 759, 765 (2<sup>nd</sup> Cir. 1976). Moreover, the descriptiveness of a term must be determined as applied "to the goods or services involved," that is, the goods or services set forth in the application. Abcor, 200 USPQ at 218.

In support of her refusal, the Examining Attorney has made of record numerous articles demonstrating that in the insurance industry, the terms "universal" and "risk management system(s)" are widely used terms. For example, an article from the February 3, 1997, North American edition of The Economist describes a risk management system in the following manner: "Finally, Sterling Administrative Services, a third-party administrator owned by Reliance Insurance Co., has upgraded its online risk management

system. Risk managers can now view daily updates on total claims experienced to date, frequency of injuries and other information." The Examining Attorney's evidence also demonstrates that on occasion, the term "risk management system" is shortened to simply "risk system." In addition, the Examining Attorney has demonstrated that the terms "universal" and "universal risk" are used to refer to insurance programs which provide protection against a number of risks such as disability, death and loss of income. See the April 22, 1995, edition of the Star Tribune.

In response, applicant makes essentially two arguments. First, applicant states that its "mark must be viewed as a whole and that it is not so 'highly descriptive' as to be unregistrable." (Applicant's brief page 2). Obviously, in determining whether applicant's mark is merely descriptive, we must consider the mark in its entirety. However, the issue before us is whether applicant's mark is merely descriptive. The issue is not whether applicant's mark is "highly descriptive."

Second, applicant makes the following argument at page 2 of its brief: "Quite simply stated, the elimination of the word 'management' [from applicant's mark] results in a mark which does not describe the services when taken as a

whole. 'Risk systems' without the term 'management' does not provide sufficient information to immediately convey a quality or attribute of the goods [sic services]. The elimination of the word 'management' provides such little information that one cannot immediately discern any quality or feature of the services. It is, respectfully, submitted that the Examiner is reading the term 'management' into the mark." See also page 1 of applicant's reply brief where applicant again emphasizes that its "mark does not include 'management.'"

There are two problems with applicant's second argument. First, as previously noted, the Examining Attorney has made of record articles wherein on occasion the term "risk management system" is shortened to simply "risk system." Thus, the term "risk system" is, by itself, a recognized term even when it does not include the word "management."

Second, as noted in Abcor, the descriptiveness of a term must be determined as applied "to the goods or services involved." 200 USPQ at 218. Applicant's chosen description of its services is "insurance risk management services." (emphasis added). Thus, upon seeing applicant's proposed mark UNIVERSAL RISK SYSTEMS used in connection with "insurance risk management services,"

consumers would mentally "read into" applicant's mark the word "management" and thus would understand applicant's mark as the descriptive term "universal risk management systems."

Finally, we note that in a companion application seeking to register HOSTED UNIVERSAL RISK SYSTEMS for identical services (S.N. 75/212,509), applicant disclaimed the exclusive right to use "universal risk systems." This is additional evidence that this latter phrase is descriptive of applicant's services. 2 J. McCarthy, McCarthy On Trademarks and Unfair Competition Section 19:65 at page 19-115 (4<sup>th</sup> ed. 1999).

Decision: The refusal to register is affirmed.

E. W. Hanak

P. T. Hairston

C. M. Bottorff  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board